

Appl. No. 10/679,027  
Am dt. Dated June 2, 2005  
Reply to Office action of 03/03/2005

### REMARKS

Claims 1-13, 15-17, 19-24, and 29-35 are now pending in the referenced application. Claims 25, 27 and 28 are withdrawn and canceled in this amendment, and claims 14, 18 and 26 were previously cancelled. A response to the Examiner's Detailed Action follows.

#### *Claim Rejections - 35 USC 102*

1. Claims 22 and 23 have been rejected under 35 USC 102(b), as being anticipated by a conventional chess game as official notice.

Applicant respectfully submits that the conventional chess game does not have any spaces that are *designated as a trap space* as cited in the first clause of claim 22. Rather, a playing piece can be removed from the chess game when it is attacked by an opposing player, regardless of which space the piece is on. It is important to recognize that the term "trap space" is consistently defined throughout the specification as a space that is "marked ... in a way that indicates the location of ... trap spaces" (pg. 13, lines 30-31), or "spaces 302 are clearly marked on the board 300 as trap spaces 310. The ... trap spaces 310 provide means for permanently removing pieces from the game" (from the section labeled "The Board" on page 14, lines 21-25). It can be seen in the drawings (e.g., Figure 1) that the trap spaces 310 are indicated by a physical (visible) marking such as a dark line around the space. Another example of marking trap spaces is provided on pg. 13, lines 30-31 where the specification states: "The chess board is adapted by being marked (e.g., by placing a coin in the space) in a way that indicates the location of preferably four trap spaces". This statement makes it explicitly clear that the inventive game board is physically and visibly different than the game board taught for use in the conventional chess game.

Thus the designation of a trap space is a visual indication on the board of fixed spaces that play a role in the method of the inventive game being claimed in claims 22 and 23. Furthermore, the designated "trap spaces" themselves are responsible for removing a piece that is moved onto it, unlike the method of game playing taught by the conventional chess game.

As stated in MPEP 706.02 (DISTINCTION BETWEEN 35 USC 102 AND 103): "for anticipation under 35 USC 102, the reference must teach every aspect of the claimed invention either explicitly or implicitly." Applicant respectfully submits that the conventional chess game does not teach every aspect claimed, especially the aspect of "designating one or more spaces as trap spaces."

Appl. No. 10/679,027  
Amdt. Dated June 2, 2005  
Reply to Office action of 03/03/2005

It also should be noted that the term "adjacent" used in claim 22 is the commonly understood meaning of "next to; adjoining", i.e., sharing at least one point of their boundaries in common. Claim 23 further limits the definition of the term to mean "orthogonally adjacent" as defined in the specification and cited in the claim (row-wise or column-wise). The conventional chess game's teaching also does not require that a second one of the player's pieces must be adjacent to a first one of the player's pieces in order to prevent removal of the first piece from the game.

Another difference from the conventional game of chess is that Applicant's game playing method specifies that the *only* way to remove a piece from the game is to leave the piece on a trap space when it is unprotected, i.e., no friendly piece adjacent to it (see paragraph on removal, pg. 20, lines 4-17). In chess, there is no such visually identified space, and there are many ways to capture and remove enemy pieces, all of which are independent of which space on the board is occupied.

For the sake of more distinctly claiming the subject matter which the applicant regards as his invention, claim 22 is hereby amended to present the rejected claim in *prima facie* condition for allowance. The wording of the claim has been somewhat re-arranged for simplification and clarification, and a few of the citations are expanded to provide more precise description, but no new material is added, and neither is the subject matter of the claim changed in any way.

In the first clause, the meaning of "designating" is clarified by adding the phrase "by visibly marking the trap spaces". This definition of designating is supported by the specification as noted above.

The original second clause is split by inserting a new second clause that more clearly defines the act of moving a piece. Thus the passive phrase "is moved into" is replaced by the method step of "allowing a player to move a piece into a trap space".

The remainder of the original second clause is now contained in the new third clause, wherein the conditions for piece removal are spelled out in more detail by adding phrasing from the original third clause but stating it in the negative. The word "only" is added to emphasize that being on an unprotected trap space is the *only way to remove a piece from the game*.

Finally, the last clause is simplified and clarified by restating the final part of the original last clause as a positive step of the method. For example, "preventing removal of the first one of the player's pieces..." is restated as "specifying that a first one of the player's pieces ...will not be removed...."

Appl. No. 10/679,027  
Ammdt. Dated June 2, 2005  
Reply to Office action of 03/03/2005

Claim 23, depending from independent claim 22, is not amended since it should be allowable as a claim further limiting a claim that is believed to be allowable.

2. Claims 25, 27 and 28 have been rejected under 35 USC 102(b), as being anticipated by DeLessio et al. (USP 5,451,061).

As argued in the previous amendment letter, Applicant still maintains that DeLessio's space labeled 46 is not "identifiable as [a] trap space for removing from the game a piece that is moved into" it. Being identifiable as a trap space is a physical characteristic of the apparatus. The phrase "for removing from the game..." etc. is a definition for the term "trap space". The applicant's physical embodiment of a trap space consists of a single space, whereas DeLessio's space 46 is a space at the beginning of, and therefore is part of, an alternate path on the game board which is collectively termed "jail". Therefore, if DeLessio's game apparatus is considered to have a "trap", this would generally be understood to be the series of adjacent spaces from 46 to 48 that are labeled on the board as a "jail". (See DeLessio column 3, lines 20-28.) Applicant's trap space is adjacent to other non-trap spaces such that pieces can be moved into the trap space from an adjacent non-trap space; whereas DeLessio's jail beginning at space 46 is physically located away from (i.e., non-adjacently to) all of the non-trap (non-jail) spaces.

In recognition of the final status of the present office action, claims 25, 27 and 28 are hereby withdrawn from consideration in the present application, and are therefore canceled.

#### *Allowable Subject Matter*

3. Examiner has stated that claims 1-13, 15-17, 19-21, 24 and 30-35 are allowed. These claims are not amended herein.

4. Examiner objects to claim 29 as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Therefore claim 29 has been rewritten in independent form including all of the limitations of the base claim 25 and the intervening claim 27. The text from claims 25 and 27 has been substantially copied into the rewritten claim 29, without any changes of substance to any of these claims.

Applicant wishes to note that should Examiner find merit in Applicant's arguments

Jun 03 05 01:40P

Dwight A. Stauffer

(216) 381-6599

p. 15

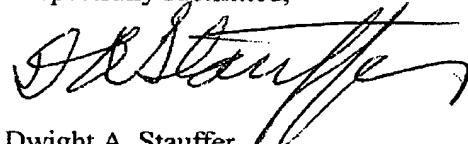
Appl. No. 10/679,027  
Amdt. Dated June 2, 2005  
Reply to Office action of 03/03/2005

hereinabove concerning the allowability of claim 25, then Applicant would prefer to leave claims 25, 27, 28 and 29 intact as previously presented.

*Conclusion*

The undersigned Agent of Record has made a sincere effort to appropriately amend the claims in response to the present Final Office Action. Favorable consideration is respectfully requested.

Respectfully submitted,



Dwight A. Stauffer  
Registration No. 47,963

D.A. Stauffer Patent Services LLC  
1006 Montford Rd.  
Cleveland Hts., OH 44121  
Phone/Fax: 216-381-6599

os-101 fam.doc

---

**CERTIFICATE OF TRANSMISSION BY FACSIMILE**

I hereby certify that this correspondence is being transmitted to the United States Patent and Trademark Office (Fax No. 703-872-9306) on June 3, 2005.

Name of Person Signing Certificate : Dwight A. Stauffer

Signature : 

Date of Person signing : June 3, 2005